

Remarks

I. Introduction

This is in response to the Office Action dated November 3, 2009.

The Office Action rejected claims 1-4, 6-7, 9-10, and 21-22 under 35 U.S.C. §101.

The Office Action rejected claims 1-4, 6-7, 9-14, 16-17, and 19-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0198803 to Rowe ("Rowe") in view of U.S. Patent No. 5,923,016 to Fredregill et al. ("Fredregill") and U.S. Patent No. 3,634,669 to Soumas et al. ("Soumas") and "Shop 'n' save – or save 'n' shop?" by Charles A. Jaffe, Seattle Times, Seattle, Wash, Feb 21, 2000 pg. C2 ("Jaffe").

The Office Action rejected claims 21-24 under 35 U.S.C. §103(a) as being unpatentable over Rowe, Fredregill, Jaffe and Soumas as applied to claim 1 and 11 and further in view of "New B of A Card Offers Discounts on Bank Products" by Jennifer Kingson Bloom, American Banker, New York, NY, December 1, 1997, Vol. 1162, Issue 229, pg. 23.

In response, Applicants have amended claims 1 and 11. Claims 5, 8, 15, and 18 were previously canceled. Claims 1-4, 6-7, 9-14, 16-17, and 19-24 remain for consideration.

II. Interview Summary

A telephonic interview between Applicants representative, Joseph G. Fenske, Reg. No. 54,592, and Examiner Harish T. Dass was conducted on January 28, 2010. During the interview the rejections of claims 1-4, 6-7, 9-10, and 21-22 under 35 U.S.C. §101 and the rejections of claims 1 and 11 under 35 U.S.C. §103 as being unpatentable

over the cited references were discussed. No agreement as to the allowability of any of the claims.

III. Rejections under 35 U.S.C. §101

The Office Action rejected claims 1-4, 6-7, 9-10, and 21-22 under 35 U.S.C. §101. Under 35 U.S.C. §101, a process must be 1) tied to a machine or 2) transform underlying subject matter to a different state or thing in order to be statutory subject matter. See In Re Bilski, 88 USPQ 2d 1382 CAFC (2008).

Applicant has amendment independent claim 1 to recite “depositing value as principal corresponding to a consumed item of a supplier into a consumable account device comprising a memory and a controller.” The consumable account device of claim 1 now comprises a memory and a controller and is therefore tied to a machine as required under 35 U.S.C. §101. Claims 2-4, 6-7, 9-10, and 21-22 depend from claim 1 and therefore are also tied to a machine as well. As such, currently amended claim 1 and dependent claims 2-4, 6-7, 9-10, and 21-22 now claim statutory subject matter. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1-4, 6-7, 9-10, and 21-22 under 35 U.S.C. §101.

IV. Rejections under 35 U.S.C. §103

Independent claim 1 was rejected as being unpatentable over Rowe in view of Fredregill, Soumas and Jaffe.

In order to “establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art.” In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. The cited references, separately or in combination, do not teach all of the claim limitations of currently amended independent claim 1. Therefore, Applicants request the withdrawal of the rejections under 35 U.S.C. §103(a).

The subject area of the present disclosure relates generally to a consumption investment system. Figure 1 depicts an exemplary consumable investment system 100 that includes a consumable account device 102, suppliers 104 and 106, consumers 108-112, and a network 114. As described in paragraphs [0008]-[0009],

[t]he consumable investment system 100 provides an ability for the consumers 108-112 to take advantage of their past consumption of an item to leverage benefits for future consumption. The item may be any purchasable objects or services. For example, the consumer 108 may purchase food from a grocery store that is a subscriber to the consumable investment system 100. The value corresponding to the purchased groceries may be deposited in an account as principal for the consumer 108. After some period of time, the account may yield interest based on the deposited principal in the form of purchasing power at the same grocery store, for example.

Paragraph [0011] indicates that “[a]greements between consumers 108-112 and the suppliers 104-106 (or other consumable investment providers) may be drafted to achieve various business goals...[I]f the agreement is to encourage customers 108-112 to consume a new item during its introduction, for example, a shorter period may be set so that more immediate gratification may be provided. Other parameters may be specified or adjusted in the agreement...”

One particular agreement is claimed in claim 1 which includes the limitation of “accruing earned value at consumable account device for future consumption of the consumed item based on the principal and an interest rate applied to the principal.” This limitation is not disclosed by the cited references.

The Office Action admits that “Rowe does not explicitly disclose wherein the earned value is solely for further consumption of the consumed item.” The Office Action indicates that Fredregill “discloses an in-store points redemption system wherein

customers can redeem accumulated points only at the retailer outlet associated with those purchases (Abstract).”

Although Fredregill discloses an in-store points redemption system wherein customers can redeem accumulated points only at the retailer outlet associated with those purchases, limiting points redemption to a particular retailer is not the same as limiting the points redemption to the same item. Thus, Fredregill does not disclose the limitation of “accruing earned value at consumable account device for future consumption of the consumed item based on the principal and an interest rate applied to the principal” as recited in claim 1. The Office Action does not indicate that Rowe, Soumas or Jaffe disclose this limitation. Further, the cited references do not disclose this limitation.

Independent claim 11 contains a limitation similar to the limitation of claim 1 discussed above. As such, the cited references do not disclose each and every limitation of claim 11 for reasons similar to those discussed above in connection with independent claim 1. Since the cited references, separately or in combination, do not disclose each and every limitation of claims 1 and 11, the cited references cannot render claims 1 and 11 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1 and 11 under 35 U.S.C. §103(a).

For the reasons discussed above, all independent claims are allowable over the cited art. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable.

V. No New Matter has Been Added

The amendments to claim 1 do not add new matter. Support for these amendments can be found at least in Figure 3 and in paragraphs [0021] to [0025] as originally filed.

The amendments to claim 11 do not add new matter. Claim 11 was amended to correct a clerical error.

VI. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

If this communication is filed after the shortened statutory time period has elapsed and no separate Petition is enclosed (or the enclosed Petition is insufficient), the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 06-2143.

Respectfully submitted,

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Date: February 2, 2010